

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hyung-Jong KANG et al.

Application 10/673,207

Group Art Unit: 2625

Filed: September 30, 2003

Examiner Akwasi Sarpong

Customer No.: 38209

Confirmation No. 9591

For: APPARATUS AND METHOD OF SCANNING AND/OR PRINTING AN
IMAGE

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Alexandria, Virginia 22313

Sir:

In response to the Office Action mailed on April 4, 2008 (hereinafter the "Office Action"), Applicants provisionally elect Species I, directed at claims 1-13 and 39-40 with traverse, and request that the Election/Restriction Requirement be withdrawn, for at least the reasons discussed below.

On pages 2-3 of the Office Action, the Examiner alleges that the claims are directed to 3 patentably distinct species:

- Species 1 of FIGS. 2-4 corresponding to claims 1-13 and 39-40;
- Species 2 of FIGS. 1A, 2, and 5-7 corresponding to claims 14-32; and
- Species 3 of FIGS. 1B and 2 corresponding to claims 33-38.

On page 4 of the Office Action, the Examiner indicates that claim 1 is generic to all the species. As described above, Applicant provisionally elects Species I, with traverse, and request that the Restriction Requirement be withdrawn, for at least the following reasons.

First, insofar as claim 41 was added in the Amendment of January 9, 2008, since this claim depends from claim 40, this claim should be at least included with Species 1.

Further, Applicant respectfully submits that the Examiner has not provided

adequate reasons for insisting upon the restriction as required under MPEP § 808.02.

That is, the Examiner has not explained why there would be a serious burden on the Examiner if the restriction was not required. To establish the existence of a serious burden, the Examiner must show by appropriate explanation either (A) a separate classification for the alleged several inventions, (B) a separate status in the art when they are classifiable together, or (C) a different field of search. See MPEP § 808.02.

Here however, the Examiner has not classified any of the claims into different classes or subclasses, nor has the Examiner presented any evidence of why it would be a serious burden on the Examiner if the restriction was not required. See MPEP § 808.02, (“Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reason exists for dividing among independent or related inventions”) (emphasis added).

Applicant notes that the Examiner has already examined all of these claims as per the Office Action of September 10, 2007, and an Amendment was filed on January 9, 2008, which is still outstanding.


Furthermore, Claims 1-13 and 39-41 are directed to a scanning and /or printing apparatus, similarly claims 19-32 are directed to a scanning apparatus having a printing unit. Accordingly, it is respectfully submitted that the Examiner has not shown a *prima facie* necessity to separate these claims into different species, and it is therefore requested that examination of the subject claims on the merits proceed in a single group, for at least the reason that no clear evidence has been provided to indicate that a serious burden would exist if the claims remained together, especially since these claims have not been classified in different classes or subclasses. As set forth in MPEP § 803, “[if] the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”

Accordingly, as stated above, for purposes of being fully responsive to the Restriction Requirement only, Applicant provisionally elects Species I, and respectfully requests that, for at least the reasons discussed above, the Election/Restriction Requirement be withdrawn.

Respectfully submitted,

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Date: May 1, 2008

By:  _____

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